

Information Disclosure Statement

Pursuant to instructions from Examiner Johannsen during a telephonic conference, Applicants hereby submit another Information Disclosure Statement to replace the original Information Disclosure Statement that was lost at the PTO. Further to the instructions from the Examiner, only copies of the foreign applications, foreign patents, and articles are submitted herewith.

In the specification:

Title

Please change the title to “Expression Analysis of FKBP Nucleic Acids and Polypeptides Useful in the Diagnosis of Prostate Cancer” as suggested by the Examiner. A marked version of the title page is presented herewith showing the change.

Embedded Hyperlink

The embedded hyperlinks have been removed from pages 37 and 85 as suggested by the Examiner. Marked versions of the relevant pages are presented showing the deletions.

Trademarks

The trademarks used in the specification have been capitalized and accompanied by generic terminology. Marked pages showing the corrections are presented.

In the claims:

Claims 1 and 16-20 have been amended. For the Examiner’s convenience a complete set of the claims is presented at the end of the response showing all revisions.

REMARKS

Claims 1-20 are pending in the application. Claims 21-34 have been withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention with traverse. Claims 1, and 16-20 have been amended as suggested by the Examiner. Support for the term "FKBP54" to claims 1 and 16 can be found throughout the specification and in the claims as filed. Support for the term "human" can be found throughout the specification and, in particular, at page 31, line 19 and page 87, line 3. No new matter has been added by the proposed amendments.

Amendment of the claims should in no way be construed as an acquiescence to any of the Examiner's rejections and was done solely to more particularly point out and distinctly claim the invention to expedite the prosecution of the application. Applicant reserves the right to pursue the claims as originally filed in this or a separate application(s).

Rejections under 35 U.S.C. § 112, 1st paragraph

Claims 1-20 are rejected under 35 U.S.C. § 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to make and/or use the invention. In particular, the Office Action states that:

“because the specification, while being enabling for methods of assessing whether a human subject has prostate cancer and methods for monitoring the progression of prostate cancer in a human subject in which increased levels of FKBP54 expression products are detected, does not reasonably provide enablement for methods of detecting or monitoring prostate cancer in any type of subject The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to use the invention commensurate in scope with these claims.”

Applicant respectfully disagrees with the rejection. However, to expedite prosecution of the application, Applicant has amended independent claims 1, and 16 to recite a “human subject,” as suggested by the Examiner. In light of this amendment to the claim, the rejection is rendered moot.

Claims 1-15 and 16-20 are also rejected under 35 U.S.C. § 112, first paragraph as lacking enablement for a second reason:

“The teachings of the specification provide sufficient evidence to establish that a particular FKBP marker, FKBP54, is expressed at higher levels in at least some types of prostate cancers as compared to healthy prostate tissue in human subjects (see, e.g., page 92),. . . the claims are sufficiently broad so as to encompass the detection of any difference in the levels of expression of any type of FKBP marker in any type of subject as an indicator of cancer or cancer progression.”

Although Applicants also disagree with this basis of the rejection, in order to expedite prosecution of the application, Applicants have amended independent claims 1 and 16 to recite “FKBP54,” as suggested by the Examiner, thereby rendering the rejection moot.

Rejection of Claims 17-20 under 35 U.S.C. 112 second paragraph

Claims 17-20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In particular, the Office Action asserts that:

Claims 17-18 are unclear and indefinite because claim 17 is currently written such that it depends from itself rather than from preceding claim 16....

Claims 19-20 are unclear and indefinite...because claim 19 is currently written such that it depends from itself rather than from preceding claim 18.

Applicants thank the Examiner for pointing out these errors, and have amended claims 17-20 to correct the dependency. Accordingly, the Examiner is respectfully requested to withdraw the rejection.

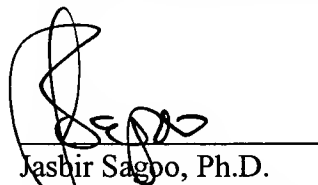
CONCLUSION

In summary, the above-identified patent application has been amended and reconsideration is respectfully requested for all the reasons set forth above. In the event that the amendments and remarks are not deemed to overcome the grounds for rejection, the Examiner is kindly requested to telephone the undersigned representative to discuss any remaining issues.

Respectfully submitted,

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